

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

Serial Number: 09/785,969

Filing Date: February 17, 2001

Title: METHOD AND APPARATUS FOR ACCESSING AND STORING DIGITAL IMAGES

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Remarks

Claims 1-4, 7-27, 29-34 and 36 are pending.

1. Claims 1-3, 7-10, 13-16, 18, 24-27, 33, 334 and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Parulski (U.S. 6,836,617) in view of the newly cited Safai (6715003) and further in view of Miyamoto (U.S. 6,456,391).

Claims 1, 13 and 15

Claims 1 and 13 recite displaying a price for storing the at least one digital image at the remote site, prompting a customer for payment of the price, receiving a payment for storing the at least one digital image at the remote site, storing the at least one digital image at the remote site, and printing a sales receipt that includes the price paid for storing the at least one digital image at the remote site, the date the payment was received, and a thumbnail of the at least one digital image stored at the remote site. Claim 15 is a system counterpart to method Claim 1 and recites similar limitations.

The Examiner asserts that Safai discloses the acts of displaying a price, prompting a customer for payment of the price and receiving a payment. This assertion is not correct. The passages in Safai cited by the Examiner in support of his assertion are quoted below in full.

"In this context, 'Develop' refers to virtual development of a digital image, that is, transport of a digital image from camera 100 to some external storage and service location for remote storage, photographic processing, printing, or forwarding." Column 25, lines 45-50.

"Selection screen 1000 may also include a price field that displays a price value representing the cost to the user of camera 100 of preparing and sending the desired quantity of photographic prints. The price value displayed in the price field may be computed and displayed by software elements 220 based on a table of prices stored in the camera or otherwise accessible to the camera. In an embodiment, the table of prices may be updated with new prices in subsequent steps of the process of FIG. 12B when an image is sent for development. Thus, camera 100 may be updated periodically to acquire new price values as processing prices provider, log in using a pre-determined user name and change. To indicate that the displayed price value is acceptable, the user may select the NEXT option 415c." Column 27, lines 30-43.

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There is nothing in these passages from Safai that teach or even suggest prompting a customer for payment or receiving payment. So far as Applicant can tell, there is nothing anywhere in Safai that addresses payment. Safai, therefore, does not supply the teachings the Examiner acknowledges are missing from Parulski and Miyamoto. For this reason alone, the Examiner has failed to carry his burden of establishing a prima facie case of obviousness. The rejection of Claims 1, 13 and 15, and their respective dependent claims should be withdrawn.

The Examiner continues to assert that Miyamoto's index print of thumbnail images is a sales receipt because "it is the confirmation of all images stored." First, a sales receipt is more than a confirmation of images stored. The price paid and the date of payment are inherent characteristics of any *sales* receipt. If the Examiner disagrees, he is respectfully requested to produce *evidence* to support his assertion because there is, as yet, no supporting evidence in the record. Second, Claims 1, 13 and 15 expressly recite a sales receipt that includes the price paid and the date of payment. Miyamoto's index print of thumbnail images does not include these features and there is nothing in Miyamoto, Parulski or Safai that even remotely suggests a sales receipt that includes the price paid and the date of payment. Again, if the Examiner disagrees, he is respectfully requested to produce evidence to support his position. Miyamoto does not teach or suggest the sales receipt of Claims 1, 13 and 15. For this additional reason, the Examiner has failed to carry his burden of establishing a prima facie case of obviousness. The rejection of Claims 1, 13 and 15, and their respective dependent claims should be withdrawn.

Claim 19

Claim 19 recites a card reader and a processor responsive to the card reader programmed to perform a point-of-sale financial transaction for sending digital images from a user's digital camera to a remote storage site. In support of the rejection of Claims 19, the Examiner again states only that "Claims 19-21 are rejected for the same reasons set forth for the method claim above." So, the Applicant is again pointing out that the Examiner's apparent reference to the method of Claim 1 is misplaced because

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Claim 19 contains limitations not found in Claim 1. In fact, so far as Applicant can tell, neither Parulski, Safai nor Miyamoto alone or in combination teach or suggest the mini-kiosk of Claim 19. Absent some showing to the contrary, the rejection of Claim 19-21 should be withdrawn.

Claim 24

Claim 24 recites a program for instructing a processor to receive digital images via the interface, determine a price for storing the digital images at a remote site, process payment information and send paid-for digital images to the remote site. The Examiner still does not specifically address the limitations of Claim 24 in the pending Office Action. The Examiner makes some vague assertions at pages 6-7 of the Action about a computer program to "determine a price for storing the digital images at a remote site, process payment information, and send paid-for digital images to the remote site...." These assertions are not supported by citation to any reference. Furthermore, the Examiner's discussion of method Claim 1 does not address the pricing and payment limitations in Claim 24. The Examiner has, therefore, failed to establish a prima facie case of obviousness as to Claim 24, and 25-32 depending from Claim 24.

2. Claims 4, 17, 22, and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Parulski in view of Safai and further in view of www.telepix.com. The Examiner's remarks are identical to the remarks made in the last office action except the word "Safai" is substituted for the word "Bidun" despite the fact that Safia and Bidun are different patents with different teachings. The Examiner has not addressed the obvious inconsistencies and errors in his supporting remarks noted by Applicant in responding to the prior action.

Claims 4-5, 17 and 22-23 are all dependent claims that are allowable due to their dependence on an allowable base claim (as detailed above). It is not clear if the Examiner intends the combination of Parulski, Safai and www.telepix.com as an independent ground for rejecting the base claims too, or if the Examiner mistakenly failed to also cite to Miyamoto, as in the rejection of the base claims. In any event, the Examiner asserts that www.telepix.com teaches printing a receipt. The only discussion of a receipt in

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telepix appears to be on page 3 of the reference, marked 2X. There is no further discussion of printing a receipt or a discussion detailing the form of the receipt in the www.telepix.com reference (2X). In fact, there is some question as to whether the receipt is even a sales receipt. Claim 4 depends from Claim 1 which recites "printing a sales receipt including the price paid for storing the at least one digital image at the remote site, the date the payment was received and a thumbnail of the at least one digital image stored at the remote site." Telepix does not teach or even suggest any such receipt.

Claim 17 depends from Claim 15. Claim 17 includes the elements of Claim 15 which recites "means for printing a sales receipt including the price paid for storing the digital images at the remote site, the date the payment was received and information identifying the stored images." Again, telepix does not teach or even suggest any such receipt..

Claim 22 depends from Claim 19. Claim 22 includes the elements of Claim 19 which recites

...a processor responsive to the card reader and programmed to perform a point-of-sale financial transaction for sending digital images from a user's digital camera to a remote storage site, the processor confirming storage of digital images at the remote storage site in response to confirmation sent from the remote storage site...

Claim 22 also adds "...a receipt printer coupled to the processor; whereby the processor can command the printer to print out receipts of the transactions." Claim 23 depends from Claim 22 and adds that the processor commands the printer to print receipts including thumbnails of paid for images. The complete recitations included in Claim 22 (and Claim 19) are not taught in the references.

If the Examiner persists in this rejection of Claims 4, 17, 22 and 23, he is respectfully requested to specifically address all claim limitations and explain how the cited references either alone or in combination teach or suggest all of the claim limitations, including citing to and explaining specific passages in the references. Absent such a showing, the rejection of Claims 4, 17, 22 and 23 should be withdrawn.

The foregoing it believed to be a complete response to the pending office action.

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Respectfully submitted,

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